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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,733	12/24/2003	Tadayoshi Iijima	247101US	9687

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C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT PAPER NUMBER

1762

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/743,733	IIJIMA, TADAYOSHI	
	Examiner	Art Unit	
	William P. Fletcher III	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4 and 6-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 6-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's compliant amendment and remarks were received May 16, 2006.
2. Claims 1, 2, 4, and 6-14 are now pending.

Response to Arguments

3. Applicant's arguments, see the remarks, filed May 16, 2006, with respect to the objections to the specification and rejections under 35 USC 112, 2nd Para., have been fully considered in view of applicant's amendment and are persuasive. These objections and rejections are withdrawn.

4. Applicant's arguments with respect to claims 1, 2, 4, and 6-11 have been considered but are moot in view of the new ground(s) of rejection. While applicant's amendment have placed the claims in such a form that they are no longer anticipated by Yokinobu, it is the examiner's position that the claims, as-amended, remain obvious over this reference as explained below.

5. Applicant's arguments filed May 16, 2006, with respect to certain features of Yokinobu, have been fully considered but they are not persuasive.

A. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that "the compression of a layer of functional fine particles and the transfer of the layer from the transfer support to the support occur simultaneously;" and that, in the process of US '792, "it is impossible to use a film like PET film which does not have a heat resistance property) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

B. Applicant argues that “the obtained PET film [of US ‘792] is poor in flexibility.” Applicant had provided no evidence in support of this assertion and it is, consequently, not persuasive. Further, the instant claims are not limited so as to require any particular flexibility; consequently, this argument is not commensurate in scope with the claims as-written. Again, while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

C. Applicant finally argues that “US ‘792 requires multi steps for the compression and the transfer, which is inefficient.” This is not persuasive because the claims recite the transitional phrase “comprising” which means that the claims are open to the presence of steps other than those explicitly recited.¹

Claim Objections

6. Claim 1 is objected to because of the following informalities: “10 μ m or less” should, apparently, read “10 μ m or less.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 2, 4, and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yokinobu et al. (US 5,411,792 A).

This reference is applied herein again as in the prior Office action.

This reference teaches particle sizes of 0.1 micron or less [15th Embodiment].

¹ MPEP § 2111.03

With respect to the temperature, the examiner acknowledges that this reference teaches a step of heating to 400°C. However, applicant's claim limitation of "drying...at a temperature of 10 to 150°C" is inclusive of ambient room temperature (~25°C, for example). It is the examiner's position that, in the process of Yokinobu, during the period between application of the ITO dispersion and drying at 400°C, the film is at room temperature and evaporation of solvent is taking place. Consequently, this claim limitation is satisfied.

With respect to the roll press force, as noted in the prior Office action, it is the examiner's position that the compressive force is a result-effective variable effecting the resistance value of the conductance particles. Consequently, it would have been obvious to one of ordinary skill in the art to modify the method of Yokinobu so as to optimize the compression force by routine experimentation, absent unexpected results demonstrating this range to be critical. See MPEP 2144.05.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

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In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 0900h-1700h.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



William Phillip Fletcher III
Patent Examiner (FSA), USPTO
Art Unit 1762

Fredericksburg, VA
August 1, 2006